REMARKS

Claims 1-23 are pending. Reconsideration and allowance of the pending claims are respectfully requested in light of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. §103

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (hereinafter "AAPA") in view of U.S. Patent No. 6,304,978 to Horigan (hereinafter "Horigan"). Applicants respectfully traverse the Examiner's position for the following reasons.

As the PTO recognizes in MPEP § 2142:

> ...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

1. Even when combined, the references do not teach the claimed subject matter.

The cited references cannot be applied to reject independent claim 1 under 35 U.S.C. §103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 1 as amended recites, in part:

> instantaneously reducing the frequency at which the processor operates if the output current of the power adapter exceeds a first threshold current level; and
>
> instantaneously reducing the frequency at which the processor operates if the output current of the battery exceeds a second threshold current level.

The Examiner concedes that AAPA fails to teach these elements and cites Horigan as doing so. Applicants respectfully traverse the Examiner's position in this regard. In particular, Horigan describes, at column 5, lines 34-44 (emphasis added):

> The embodiment illustrated in FIG. 2 utilizes a power supply 240 having a current change response circuit 250.... Power is provided from a power supply circuit 245 to a processor 205 via a power supply line 247. The current change response circuit 250 generates a throttle signal on a signal line 262 to throttle the processor 205 when a change in current supplied exceeds a threshold value. Accordingly, the rate of change of current may be controlled.

From the cited passage it is clear that Horigan is concerned with monitoring a rate of change of current, not an instantaneous current level. As described above, the current change response circuit 250 generates a throttle signal when a change in current exceeds a threshold value; clearly, this is literally and functionally different than the invention recited in claim 1, which "throttles" the processor when an output current level exceeds a predetermined threshold current level. To reiterate, the system of Horigan monitors a current change, which by definition occurs over a period of time, while Applicants' claimed invention monitors a current level, which can occur instantaneously. As a result, Applicants' invention, as recited in claim 1, allows for a faster response to a change in power draw of the processor.

In view of the foregoing, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1, as well as claims 2-7 dependent therefrom, under 35 U.S.C. §103 should be withdrawn and those claims allowed.

Independent claims 8, 11, 12, 13, 17, 20 and 23 include limitations similar to those of claim 1 and should therefore be allowed for at least the same reasons set forth above. Claims 9, 10, 14-16, 18, 19, 21 and 22 depend from and further limit claims 8, 13, 17 and 20, and are therefore also deemed to be in condition for allowance for at least that reason.

2. The combination of references is improper.

Assuming, *arguendo*, that when combined, the references teach the claimed subject matter (which is clearly not the case, as demonstrated above), there is another, mutually exclusive, and compelling reason why the references cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides:

> ... The examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.... The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither AAPA nor Horigan teaches or even suggests the desirability of the combinations as recited in the claims. In particular, neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

The MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In this context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the independent claims. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Conclusion

For at least the reasons set forth in detail above, independent claims 1, 8, 11, 12, 13, 17, 20 and 23 are deemed to be in condition for allowance. Claims 2-7, 9, 10, 14-16, 18, 19, 21 and 22 depend from and further limit independent claims 1, 8, 13, 17 and 20 and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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